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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/606,707	06/25/2003	Toshiyuki Matsumura	03376/HG	5092
1933	7590	08/25/2004	EXAMINER	
FRISHAUF, HOLTZ, GOODMAN & CHICK, PC 767 THIRD AVENUE 25TH FLOOR NEW YORK, NY 10017-2023			GILLIAM, BARBARA LEE	
			ART UNIT	PAPER NUMBER
			1752	

DATE MAILED: 08/25/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/606,707	<b>Applicant(s)</b> MATSUMURA, TOSHIYUKI	
	<b>Examiner</b> Barbara L. Gilliam	<b>Art Unit</b> 1752	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 30 October 2003.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>10/30/2003</u> . | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Priority***

1. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

### ***Claims***

2. Claims 1-10 are present.
3. The claims of record are "product-by-process" claims. Applicant is reminded of MPEP 2113 & *In re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985): "[E]ven though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process."

### ***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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5. Claims 1-10 are rejected under 35 U.S.C. 102(b) as being anticipated by Higashi et al. (EP 1 096 314 A1).

a. The lithographic printing plate precursor of Higashi et al. meets the present limitations for the light sensitive planographic printing plate precursor. The printing plate precursor of Higashi et al. comprises an aluminum support having thereon a photopolymerizable photosensitive layer which meets the present limitations for the light sensitive composition. Specifically the photopolymerizable photosensitive layer contains an alkali-soluble urethane binder having at least one ethylenically unsaturated polymerizable group on the side chain thereof, an addition polymerizable compound having an ethylenically unsaturated double bond and a photopolymerization initiator (abstract). The alkali-soluble urethane binder is obtained by the reaction between (A) a diisocyanate compound containing an ethylenically unsaturated group and (B) a diol compound containing an alkali-soluble group. The diisocyanate compound is obtained by allowing (A1) a compound having three or more isocyanate groups and (A2) an ethylenically unsaturated compound having an active hydrogen group to react ([0014]-[0018]). Compounds (A1) and (A2) meet the present respective limitations for the aromatic diisocyanate compound and the compound having a hydroxyl group and an addition polymerizable ethylenically double bond. Compound (B), the alkali-soluble group containing diol compound meets the present limitations for the tertiary amine, specifically compound No. 67 ([0019]-[0048]). The addition polymerizable compounds including the polyfunctional acrylates and methacrylates meet the present limitations for the

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polymer binder ([0068]). The photopolymerization initiators having a carbon-halogen bond (i), meet the present limitations for the same ([0070], [0080]).

### ***Conclusion***

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

a. US 6,475,700 B1 is in the same patent family as EP 1 096 314 A1.

b. In EP 0 602 292 A1, Huynh-Tran teach photocurable polyurethane-acrylate ionomer compositions for aqueous developable printing plates.

c. In US 2004/0091816 A1, Matsumura et al. teach a photosensitive composition comprising an ethylenically unsaturated monomer, a photopolymerization initiator composition and polymer binder (abstract).

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Barbara L. Gilliam whose telephone number is 571-272-1330. The examiner can normally be reached on Monday through Thursday, 8:00 AM - 5:30 PM.

a. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia Kelly can be reached on 571-272-1526. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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b. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

*Barbara L. Gilliam*

Barbara L. Gilliam  
Primary Examiner  
Art Unit 1752

bg  
August 23, 2004